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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/018,104	02/03/1998	JAMES L. HOBART	PHAN-00100	9278

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on September 30, 2002

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-14, 17-24, & 41-49 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-14, 17-24, & 41-49 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the originally filed disclosure for each of two lasers generating pulses to generate ablation, nor combining the pulses of two sources to form a predetermined coagulation depth.

Regard the Information Disclosure Statement filed May 13, 2001, the examiner notes that only references AA (Re 36,872 - Zair) through CS (5,190,032 -Zair) have been accompanied by copies thereof, as required by MPEP 609, thus the remaining citations - CT through GH have not been considered as no copies have been provided. The examiner further advises applicant that in contrast to the remainder of considered submissions, which relate in some way to laser application, or optics reference AI (3,854,153 - Fadler) relates to a fold away bed. Thus if applicant intended some other reference to be considered, that reference should be submitted.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17 and 41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dwyer et al.

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Claims 1-3, 6-8, 11-14, 17-19, 41 and 43-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dew ('969), Anderson et al, Belkin et al and Dwyer et al. Sklar et al teach a laser system including multiple lasers with a graphical interface and teach that it can be used for any type of surgery with any type of laser and that the depth of the laser action can be input and displayed. Dew ('969) teaches the use of a carbon dioxide laser operating at 10.6 microns as a cutting laser in a laser system comprised of multiple lasers and teaches that the power of a pulse determines the amount of heat deposited in the tissue and that the same type of laser can be used for cutting and coagulating. Belkin et al teach that carbon dioxide lasers operating 10.6 microns can be used to heat, rather than cut tissue. Anderson et al teach the way parameters such as absorptivity spot size, and pulse width interrelate to control the amount of energy absorbed by tissue. Dwyer et al teach performing surgery by alternating cutting and coagulation. It would have been obvious to the artisan of ordinary skill to use a carbon dioxide laser as taught by Dew ('969) in the graphical user interface of Sklar et al, since this is to be used with any laser, as taught by Sklar et al, to also configure the laser to coagulate as taught by Belkin et al, since this would render the device more versatile, at no extra cost and to employ the particular laser parameters claimed since these provide no unexpected result., and are within the scope of one having ordinary skill in the art as shown to by Anderson et al to alternate cutting and coagulating pulses, since this enables bloodless surgery, as taught by Dwyer et al; employ an articulated arm with refocussing convex lenses since these are notorious in the art for transporting infrared radiation such as that from Carbon dioxide lasers, official notice of which has already

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taken and to use a galvanometer to alternate the beams, since these are notorious for moving optical components official notice which has already been taken thus producing a device such as claimed.

Claims 4, 5, 9, 10, 20-24, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dew ('969), Anderson et al, Belkin et al and Dwyer et al as applied to claims 1-3, 6-8, 11-14, 17-19, 41, and 43-49 above, and further in view of Assa et al. Assa et al teach a scanning handpiece and the equivalence of carbon dioxide and Erbium YAG lasers. Thus it would have been obvious to the artisan or ordinary skill to employ an handpiece as taught by Assa et al, since this allows more consistency of treatment and to employ an erbium laser, since these are equivalent to the carbon dioxide laser, thus producing a device such as claimed.

Applicant argues that "Dwyer does not teach combining light from multiple lasers at all". The examiner must disagree, Dwyer et al clearly teach and actually claim the alternate production and direction to the single output of the device, two beams from two separate lasers. The examiner can see no reason why this cannot be considered "combining light from multiple lasers" and applicant has proffered absolutely no rational whatsoever upon which such a distinction can be predicated. As such the unsupported assertion of applicant that the beams of Dwyer et al are not combined is not persuasive, the fact that the instant invention contemplates the same type of beam combination notwithstanding. It is noted that since the lasers of Dwyer et al are switched on and off to produce alternating pulses of light, they are pulsed lasers.

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Regarding the combination rejections, applicant merely argues the applied references separately, completely disregarding the teachings of the combination as a whole. These arguments are not convincing.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.



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GROUP 330

David Shay:lf
December 18, 2002